

REMARKS

Claims 1-8, 16 and 18-28 are pending in the application. Claims 9-15 and 17 are cancelled. Claims 1, 16 and 18 are amended to more particularly claim Applicants' invention and to correct claim dependency due to cancelled claims. Claims 21-28 are added. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

Claim Rejections – 35 USC § 102

The Patent Office rejected claims 1, 3-5, 8, 9, 11-13, 15-18 and 20 under 35 U.S.C. § 102(e) as being anticipated by Strandwitz et al. (U.S. Patent No. 6,522,352). Claims 9, 11-15 and 17 have been cancelled obviating the rejection of these claims. Applicant respectfully traverses the rejections of the remaining claims 1, 3-5, 8, 16-18 and 20.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. MPEP § 2131; *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." MPEP § 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

With respect to claims 1, 3-5 and 8, Strandwitz et al. fails to disclose, teach or suggest a method for communicating and recording an image to a removable media device comprising the steps of "storing the communicated image in memory on the removable media device; thereafter deciphering the stored image; and recording the deciphered image on removable media of the removable media device," as presently recited in claim 1. Instead, Strandwitz et al. teaches a system wherein a captured image may be saved to a disk drive 402. Nowhere does the Strandwitz et al. reference specifically disclose that the image being saved to the disk drive is *first* saved to a memory within the disk drive, *then* deciphered or reformatted, and *finally* saved to a removable disk

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of the disk drive. Moreover, nowhere does the Strandwitz et al. reference specifically disclose “decoding the stored image from a first format into a photoframe and encoding the decoded image into a second format” as presently claimed in claims 4 and 5. Accordingly, it is respectfully submitted that *prima facie* anticipation of claims 1, 3-5 and 8 has not been established under MPEP § 2131. Withdrawal of the rejections of claims 1, 3-5 and 8 is therefore respectfully requested.

With respect to claims 16-18 and 20, Strandwitz et al. also fails to disclose, teach or suggest a method for communicating and formatting an image from an image capture device, comprising “initiating a wireless connection between an image capture device and an image storage device; querying the image storage device for a supported format; and if the supported format differs from an image format, deciphering the image to the supported format and communicating the image from the image capture device to the image storage device,” as presently recited in claim 16. The Patent Office reads the steps of “querying the image storage device for a supported format; and if the supported format differs from an image format, deciphering the image to the supported format and communicating the image from the image capture device to the image storage device” on the disclosure that the video signals are processed according to a selected protocol scheme. Applicants respectfully disagree with this generalization. Nowhere does Strandwitz et al. specifically disclose the step of “querying the image storage device for a supported format” or “deciphering the image to the supported format” if the supported format differs from the image format” as presently claimed. Moreover, nowhere does the Strandwitz et al. reference specifically disclose “decoding the stored image from a first format into a photoframe and encoding the decoded image into a second format” as presently claimed in claim 20. Accordingly, it is respectfully submitted that *prima facie* anticipation of claims 16-18 and 20 under 35 U.S.C. § 103(a) has not been established as required by MPEP § 2131. Withdrawal of the rejections of claims 16-18 and 20 is therefore respectfully requested.

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Claim Rejections – 35 USC § 103

The Patent Office rejected claims 2, 6, 7, 10, 14 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Strandwitz et al. (U.S. Patent No. 6,522,352) in view of Squilla et al. (U.S. Patent No. 6,396,537). Claims 10 and 14 have been cancelled obviating the rejection of these claims. Applicant respectfully traverses the rejections of the remaining claims 2, 6, 7 and 19.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 citing *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Moreover, when applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. See MPEP § 2141 and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Claims 2, 6, 7 and 19 depend from either claim 1 or claim 2. As noted above, Strandwitz et al. fails to disclose, teach or suggest a method for communicating and recording an image to a removable media device comprising the steps of “storing the communicated image in memory on the removable media device; thereafter deciphering the stored image; and recording the deciphered image on removable media of the removable media device,” as presently recited in claim 1 or a method for communicating and formatting an image from an image capture device, comprising “initiating a wireless connection between an image capture device and an image storage device; querying the image storage device for a supported format; and if the supported format differs from an image format, deciphering the image to the supported format and communicating the image from the image capture device to the image storage device,” as presently recited in claim 16. Squilla et al. fails to make up for this defect in the Strandwitz et al. reference

since Squilla et al. is relied on only to teach a removable media device including at least one of a digital versatile disk (DVD), digital video disk-erasable (DVD-e), VCD, and compact disc. Moreover, there exists no suggestion or motivation from the prior art to modify Strandwitz et al. or Squilla et al. to achieve Applicants' invention. Accordingly, it is respectfully submitted that *prima facie* obviousness of claims 2, 6, 7 and 19 has not been established under 35 U.S.C. § 103(a) as required by MPEP § 2143.03. Withdrawal of the rejections of claims 2, 6, 7 and 19 is therefore respectfully requested.

New Claims

Support for new claims 21-28 is found throughout the specification and drawings as originally filed. In particular, Support for new claims 21-28 is found in the specification at page 5, line 4 through page 8, line 15, and at page 9, line 3 through page 10, line 1. No new matter is added.

For the reasons noted above, neither Strandwitz et al., either alone or in combination with Squilla et al., nor the prior art in general disclose, teach or suggest a system for communicating and recording images, comprising an image capture device for capturing the image; and a removable media device having memory, the removable media device for storing the image to removable media, wherein the image capture device communicates the image to the removable media device via a wireless connection and the removable media device stores the communicated image in the memory and thereafter deciphers the image for recordation to the removable media as claimed in claims 21-24 or a system for communicating and formatting an image from an image capture device, comprising an image capture device for capturing the image; and an image storage device for storing the image to removable media, wherein the image capture device initiates a wireless connection between an image capture device and an image storage device, queries the image storage device for a supported format, deciphers the image to the supported format if the supported format differs from the image format, and communicates the image to the image storage device for storage to the removable media claimed in claims 25-28. Accordingly, it is submitted that claims 21-28 are patentable of the cited prior art and the

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prior art in general. Allowance of claims 21-28 is therefore respectfully requested.

Art Made of Record Not Relied On

Applicants will not burden the record with a discussion of art not specifically applied to the claims.

CONCLUSION

The application is respectfully submitted to be in condition for allowance of all claims. Accordingly, notification to that effect is earnestly solicited.

Respectfully submitted,
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